



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,162	09/25/2003	Barry J. Gilhuly	555255012579	7030

7590 11/30/2005
David B. Cochran, Esq.
JONES DAY
901 Lakeside Avenue, North Point
Cleveland, OH 44114

EXAMINER

REILLY, SEAN M

ART UNIT PAPER NUMBER

2153

DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



Office Action Summary	Application No.		Applicant(s)	
	10/671,162		GILHULY ET AL.	
	Examiner		Art Unit	
	Sean Reilly		2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 8-15, 18-28, 31-33 and 55-67 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8-15, 18-28, 31-33 and 55-67 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office action is in response to Applicant's amendment and request for reconsideration filed on September 12th 2005. Claims 1-5, 8-15, 18-28, 31-33, 55-67 are presented for further examination. All independent claims have been amended.

Priority

It is noted for the record that the effective filing data for the subject matter in the pending claims filed September 12th 2005 is 09/23/1999. While written description support for the subject matter amended to independent claim 1 and also incorporated within new independent claim 55 exists in application 09/401868 filed September 23rd 1999, no such support exists in application 09/087623 filed May 29th, 1998. Accordingly, the effective filing date for all pending claims is September 23rd 1999.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-5, 8-15, 18-24, 31, 32, 55-62, and 66-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over AirMobile Communication Server Guide ("AirMobile Software for Lotus cc:Mail Wireless," Motorola Publication, 1995, hereinafter "AirMobile") and

AirMobile Communication Client Guide (“AirMobile Software for Lotus cc:Mail Wireless,” Motorola Publication, 1995, hereinafter “AirMobile **Client**”) and Birrell et al. (U.S. Patent Number 6,185,551; hereinafter Birrell).

In considering claim 1, AirMobile discloses the claimed redirection method including detecting a new data item for the user at the messaging host system (cc:Mail Post Office server, Fig. 1), forwarding a copy of the data item to a redirector host system (AirMobile Wireless for cc:Mail Server, Fig. 1), configuring a set of filtering rules for use by the redirector host system in determining whether the new data item should be redirected to the user’s mobile device (AirMobile pgs 10-11 or pg 26); providing an interface that enables the user to remotely configure and reconfigure the filtering rules (AirMobile Client pg 41), and that also enables the user to remotely activate and deactivate the redirector host system for the user (AirMobile Client pg 17); if the new data item passes through the user-configured filtering rules and the redirect host system is activated, then packaging the data item in an electronic envelope and transmitting the electronic envelope to the user’s mobile device (pp. 10-11, describing the messaging system and the filtering of messages at the redirector host system, see also pp. 25-26, 35).

The AirMobile server and client guides disclosed the invention substantially as claimed however, neither the AirMobile server guide nor the AirMobile client guide disclosed that the configuration interface is a web page interface. Nonetheless, it was widely known in the art at the time of the invention to configure programs remotely via a web interface, as evidenced by Birrell. In an analogous electronic messaging system, Birrell disclosed an email system executed on a server or group of servers (Col 4, lines 6-14). Users of the email system access all aspects of the system remotely through a web page interface (Col 13, lines 26-31), including the

Art Unit: 2153

configuration of electronic mail filters (Col 11, lines 45-53). Birrell further disclosed that such a web based interface system is advantageous since users can connect to the system and perform any mail service from any web-connected client computer, thereby allowing users of the service to be mobile by moving among different clients at will (Col 4, lines 21-42). Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the web based interface system as disclosed by Birrell within the AirMobile system, so that users are able to connect to the system and perform any mail service from any web-connected client computer, thereby allowing users of the services to be mobile by moving among different clients at will.

Claims 2-5 are disclosed on page 10 of AirMobile.

Claim 8 is further disclosed by AirMobile (see AirMobile, pp. 26-27, wherein an electronic envelope is inherently necessary to send messages between the host and the mobile device).

In considering claim 9 AirMobile further discloses sending replies from the mobile device to the redirector host system (p. 26, describing messages sent by the mobile device).

In considering claim 10, the messages sent from the mobile device to the redirector server will necessarily be addressed using the address of the redirector host system.

Claims 11-12 disclose the analogous reverse steps as claim 1, and thus are rejected under the same rationale as claim 1.

In considering claim 13, AirMobile will necessarily complete the claimed steps of receiving a reply received at the redirector host system, reconfiguring address information associated with the reply, and sending the reconfigured reply data to a destination using an electronic address included in the reply data item (i.e. the messages sent from the mobile device are intended for outside recipients, so must include the address of those recipients and must have addresses reconfigured upon redirection at the redirection host system).

In considering claim 14, AirMobile further discloses the claimed gateway, and thus sending messages in the electronic envelope through the gateway (Fig. 1, wherein the "Mobidem" serves as the gateway).

Claims 15-24 are disclosed in the same sections of AirMobile discussed previously.

Claims 31 and 32 are disclosed on page 17 of AirMobile.

Claims 55-62 and 66-67 are not patentably distinct over claims 1-5, 8-15, 18-24, 31, and 32. Thus, they are rejected using a similar rationale.

2. Claims 25-28 and 63-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over AirMobile and AirMobile Client and Birrell, in view of Nelson (U.S. Patent No. 6,061,718).

In considering claims 25-26, AirMobile does not disclose that the e-mail system is run by an ISP. Nonetheless, it is well known to use e-mail over the Internet on an e-mail service run by an ISP, as evidenced by Nelson (Nelson, col. 5, line 65 – col. 6, line 4). Thus, it would have been obvious for the e-mail system taught by AirMobile to be run by an ISP because that would increase business with the ISP and would allow users to access mail from anywhere in the world.

In considering claim 27, the combined system of AirMobile and Nelson will perform the steps of including a forwarding database for detecting whether new data items received at the ISP mail server should be forwarded to the redirector host system and for determining the address of the redirector host system (AirMobile, p. 13, “Note”).

In considering claim 28, the combined system of AirMobile and Nelson will necessarily connect the messaging host system (i.e. ISP server) and redirector host system over the Internet.

Claims 63-65 are not patentably distinct over claims 25-28. Thus, they are rejected using a similar rationale.

3. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over AirMobile and AirMobile Client and Birrell, in view of LookSmart (“Motorola Brings AirMobile Software Products to the DCPD Network; Motorola Provides Mobile Corporate cc:Mail Users with Flexibility to Use Any Major Wireless Data Network,” Business Wire, January 1996).

In considering claim 33, LookSmart describes that AirMobile uses compression. It would have been obvious to include compression the in AirMobile system to save network bandwidth.

Response to Arguments

1. In response to Applicant's request for reconsideration filed on 9/12/2005, the following factual arguments are noted:

- a. The double patenting rejection set forth is no longer valid in view of the amendments filed in the instant application and the co-pending application 09/928,983.
- b. Airmobile failed to disclose configuring filtering rules through a webpage interface.

In considering (a), Examiner agrees with Applicant's argument. Accordingly the double patenting rejection is withdrawn.

In considering (b), Applicant's arguments are moot in view of the new grounds of rejection set forth.

Conclusion

2. The prior art made of record, in PTO-892 form, and not relied upon is considered pertinent to applicant's disclosure.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean Reilly whose telephone number is 571-272-4228. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2153

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

11/24/05

MARC D. THOMPSON
MARC THOMPSON
PRIMARY EXAMINER
571.272.3932